

Atty. Docket No. JP920000133US1
(590.074)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 01 2005

In re Application of : Mori et al.
Serial No. : 09/904,147 Examiner : U. Shortledge
Filed : July 11, 2001 Art Unit : 2654
For : SYSTEMS AND METHODS FOR WORD
PREDICTION AND SPEECH RECOGNITION

August 1, 2005

RESPONSE TO RESTRICTION REQUIREMENT

I hereby certify that this correspondence and any documents referred to as enclosed therewith are being transmitted by facsimile to the Commissioner for Patents on facsimile number (571) 273-8300 on August 1, 2005.


Stanley D. Ference III
Reg. No. 33,879August 1, 2005
Date of Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is responsive to the Restriction Requirement dated July 1, 2005, for the above-identified application.

The Examiner has asserted that Claims 1-6, 8-12, and 14-20, drawn to methods, an apparatus, a system, storage mediums, program transmission apparatuses, and a program storage device for word prediction (Group I), Claims 7 and 21, drawn to a

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method and program storage device for word prediction to obtain the most likely sentence structure and word sequence (Group II), and Claim 13, drawn to an apparatus for word prediction to obtain the most likely sentence (Group III), are each directed to distinct inventions. The Examiner has required Applicants to elect one group of claims for prosecution.

The asserted basis for the restriction requirement is "Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Applicants respectfully traverse the restriction requirement since the inventions are related. As seen below, the groups of claims delineated by the Office can be used together, with the apparatus and system claims used to practice the method claims, and so forth.

Firstly, the word prediction methods of Group I can be used in the claims of Group II, in which a word is predicted based on partial analysis trees. As stated in the specification of the instant invention, partial analysis trees can be used for the prediction outlined in the independent claims present in Group I (page 8, lines 6-13), and although partial analysis trees are not specifically mentioned in the claim group, usage of such trees is not precluded by the claims. Thus, the claims in Groups I and II are not unrelated according to MPEP 806.04 or 808.01 as specified in the Restriction Requirement. The claim sets of Groups I and II are capable of use together, can be used in practice together, and are connected in design and operation of the invention.

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Group III is also connected to the claims of Group I and II in a similar fashion. Claim 13 of Group III implements the prediction method of Groups I and II when "said recognizer predicts a word to be predicted based on a structure of a sentence including said word" (Claim 13) and calculates the probability value for the sentence using the steps of the independent claims of Group II. Thus, the claim in Group III is an apparatus that facilitates the methods of Groups I and II.

As shown above, the claim sets of Groups I, II, and III are capable of use together, can be used in practice together, and are connected in design and operation of the invention. Thus, the claims in Groups I, II, and III are not unrelated according to MPEP 806.04 or 808.01 as specified in the Restriction Requirement. The comments included in these sections of the MPEP, specifically those pertaining to subject matter that should be restricted, highlights the inappropriateness of the present Restriction Requirement. Accordingly, Applicants respectfully request the restriction requirement be withdrawn and all claims be examined at this time. In the event that the restriction requirement is not withdrawn, Applicants provisionally elect the claims of Group I (e.g., Claims 1-6, 8-12, and 14-20).

Further, Applicants also assert that even if the restriction requirement is not withdrawn, the claims of Groups I, II, and III should be examined at the same time under MPEP § 803 ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions"). The Office asserts that as the inventions of Groups I and II "have acquired separate status in the art as shown by their different

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classification, restriction for examination purposes is proper.” Different classifications, however, do not mean both classes would not be searched. See MPEP § 904.02(a) (“In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross-reference art collection pertinent to each type of invention claimed should be included, from the largest combination through the various subcombinations to the most elementary part. The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.”) In this regard, the Office’s attention is directed to U.S. Patent No. 6,598,018 which issued on July 22, 2003. This recently issued U.S. Patent was searched in multiple classes and is classified in multiple classes; in fact, the multiple classes for searching and classification include the three subclasses identified in the outstanding Restriction Requirement. In view of this past Office practice, there can be no credible assertion there would be a serious burden in searching and examining the claims of Groups I, II and III in the same application.

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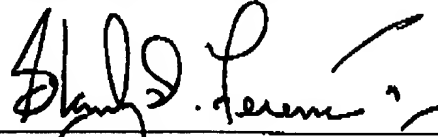
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If there are any further issues in this application, the Examiner is invited to contact
the undersigned at the telephone number listed below.

Respectfully submitted,



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